

COMMENTS

The enclosed is responsive to the Examiner's Office Action mailed on April 25, 2003. At the time the Examiner mailed the Office Action claims 23-59, and 63-86 were pending. By way of the present response the Applicant has: 1) amended claims 37-39, 55 and 68; and, 2) has added new claims 87 – 112. As such, claims 23-59 and 63-112 are currently pending. The Applicant respectfully requests reconsideration of the present application and the allowance of claims 23-59 and 63-112.

The Examiner rejected claims 55 and 68 under 35 USC 112, paragraph 2 for failing to particularly point out and distinctly claim the subject matter that is being claimed. In particular, the Examiner rejected: 1) claim 55 because of the phrase "capable of being interpreted from said transitioning"; and, 2) claim 68 because of the failure to use a period at the end of the claim. In response, the Applicant has: 1) amended claim 55 so as to recite the phrase at issue to "capable of being interpreted from said message"; 2) amended claim 68 so as to include a period at the end of the claim. The Applicant respectfully submits that by way of the above described amendments the Examiner's rejections under 35 USC 112, paragraph 2 have been overcome.

The Examiner also rejected independent claims 23, 36, 40, 53, 59, 68 and 74 under 35 USC 103(a) as being obvious in view of US Patent 6,052,448 (hereinafter, "Janning") and US Patent No. 6,317,433 (hereinafter, "Galand"). Notably, although US Patent 4,788,719 (hereinafter "Gupta") was also referenced in the Examiner's opening statement of rejection (See, Office Action mailed 4/25/03), the Examiner has apparently used Gupta only against claimed subject

matter directed to multi-party or multi-point calls. See, Office Action mailed 4/25/03, pages 5-8. As none of the Applicant's rejected independent claims 23, 36, 40, 53 and 74 are specially limited to multi-party or multi-point call implementations, the Gupta reference has no relevance to these claims. Each of rejected independent claims 59 and 68 recite the claim element "point-to-multipoint call", however. Hence, of all the Applicant's rejected independent claims, Gupta is deemed relevant only to claims 59 and 68.

Independent Claims 23, 40, 53, 59, 68 and 74

The Applicant respectfully submits that the Examiner's reasoning with respect to independent claims 23, 40, 53, 59, 68 and 74 not only blatantly fails to establish a prima facie case of obviousness; but also fails to infer the correct teachings of the Janning and Galand references.

a. failure to establish a prima facie case of obviousness

It is noteworthy that: 1) each of independent claims 23, 40, 53, 59, 68 and 74 recite subject matter directed to the reduction of the size of a call record (specifically, independent claims 23, 40, 59, 68 and 74 recite: "reducing the size of a call record"; and, independent claim 53 recites: "reduce the size of a call record"); and, 2) the Examiner expressly admits that no art has been found that discloses, teaches or suggests the reduction of the size of a call record.

In particular, the Examiner states that "Janning . . . fails to specifically teach . . . 'reducing the size of the call record maintained for the call'". See, Office Action mailed 4/25/03, pg. 4. Here, the Examiner specifically admits that

Janning fails to teach or suggest the reduction of the size of a call record.

Moreover, the Examiner states only that Galand teaches “reducing the size of [a] call”. See, Examiner’s Office Action mailed 4/25/03, pg. 4. Therefore, the Examiner has effectively admitted that no art as been found that is sufficient to cover the reduction of the size of a call **record**; and, likewise, has admitted that a prima facie case of obviousness has not been established.

b. failure to infer the correct teachings of the prior art references

The Examiner’s interpretations of the teachings of the Janning and Galand references are mis-directed as described in detail immediately below.

b.1. the Janning reference

As stated above, the Examiner has concluded that “Janning . . . fails to specifically teach . . . ‘reducing the size of the call record maintained for the call’”. See, Office Action mailed 4/25/03, pg. 4. However, in the Office Action response mailed by Applicant on February 5, 2003, the Applicant stated to the Examiner:

viewing Janning in its most favored light with respect to the Examiner’s position, Janning can only be reasonably regarded as teaching or suggesting “reducing [the size of a call record] in response to said call transitioning from an active phase to a release phase.” Here, column 4, line 4 of Janning clearly reveals that formatter 28 is engaged to reduce “raw information” into a call detail record (CDR) only “[w]hen the call is disconnected”. Because a *call disconnect* is clearly more analogous to a *release phase* than an *establishment phase* or an *active phase*, it is clear that Janning can at most only be regarded as teaching or suggesting the reducing of a call record size in response to a transition from an *active phase* to a *release phase*. Therefore Janning does not teach or suggest “reducing [the size of a call record] *in response to said call transitioning from an establishment phase to an active phase*”.

Applicant's Office Action response mailed 2/5/03 (underlined emphasis added, italicized emphasis original).

Thus, the Applicant respectfully submits that the insufficiencies of Janning are related more to Janning's failure to show a cause-and-effect relationship between the transitioning from an establishment phase to an active phase and the reducing of a call record size; rather than, as stated by the Examiner, the failure to teach or suggest the reducing of a call record size by itself.

b.2 the Galand reference

The Galand reference is simply irrelevant with respect to any of the Applicant's claims. Galand is devoted to reducing the amount of non-usable "padding" information that is stuffed into ATM cells when ATM cells are used to transport variable length packets ("PTMs") across an ATM network. In particular, a large amount of padding information is traditionally stuffed into the delimiting (i.e., last) ATM cell used to transport a packet if the packet's length is slightly beyond an integer multiple of 47 bytes (noting that, for non delimiting cells, a byte of the 48 byte ATM cell payload is consumed by cyclic redundancy check information ("CRC8" of Fig. 2 Galand) leaving 47 bytes per ATM cell for the transportation of packet data; and, for delimiting cells, 4 bytes of the 48 byte ATM cell payload are consumed by cyclic redundancy check information ("CRC32" of Fig. 2 Galand) leaving 44 bytes per ATM cell for the transportation of packet data). Thus, for example, if the packet's length is 236 bytes, 6 cells will be used to transport the packet: 5 cells that in total transport the first 235 bytes of the packet (i.e., 5 cells x 47 bytes/cell = 235 bytes) and a sixth and final cell having 1

byte of packet information and 43 bytes of unused padding information. In this example, 97.7% of the sixth cell's payload is wasted because 43 out of 44 bytes are stuffed with non-usable padding. See, Galand Col. 1, lines 29-32 and lines 36-43; Col. 4, line 51 through Col. 5, line 10.

It is the objective of Galand to reduce or eliminate this padding information by formatting packet data into ATM cells according to a novel approach. Specifically, the formatting involves replacing cell header information deemed unusable within the confines of the ATM network (specifically, control bytes "CB1" and "CB2") with a flag (F) that identifies the cell as carrying packet information and a count value (CNT); and, using 7 bits (LAB) of an LS1/LS2 label field to identify up to 128 different connections. Presumably, the CNT value allows the endpoint of a first packet to be precisely located within an ATM cell payload so that the beginning of a second packet, rather than padding, can be stuffed into the same ATM cell payload with the last piece of the first packet; and, the LAB field allows the first and second packets to be associated with different connections. See, Galand Col. 5, lines 19-24 and lines 46-59.

The Examiner has concluded with respect to claims 23, 40, 53, 59, 68 and 74 that Galand teaches "reducing the size of [a] call". See, Examiner's Office Action mailed 4/25/03, pg. 4. If the Examiner means that the size of a call, as measured by the amount of packet/cell/frame data that is transported across a network between caller and callee (which includes signaling messages), is reduced by the invention taught by Galand – the Applicant is apt to agree with the Examiner (because unused padding information is replaced with actual

substantive call information thereby reducing the total amount of information transported across a network to implement the call itself).

Fatal to the Examiner's position, however, is the fact that reducing the size of a call fails to cover a claim element directed to reducing the size of a call record. Here, a distinction is readily apparent between the term "call record" that appears in the Applicant's claims and the term "call" that also appears in the Applicant's claims. From the description of a call record made at page 3, lines 5-11 of the Applicant's specification it is clear that a call record is a record of information regarding a call (e.g., state, identification number, etc.). By contrast, the call itself is the flow of information (e.g., voice, data, signaling messages) across the network between the caller and callee. Here, to the extent the Examiner is correct that Galand teaches the reduction of the size of the call itself, it is clear that the same is insufficient to cover a claim element directed to the reduction of the size of a call record; and, likewise, it is error on the part of the Examiner to use Galand as reference for covering the reduction of a call record. Galand is simply an irrelevant reference with respect to independent claims 23, 40, 53, 59, 68 and 74 because it fails to teach any matter regarding the reduction of the size of a call record.

If the Examiner meant to state in the Office Action mailed 4/25/03 with respect to independent claims 23, 40, 53, 59, 68 and 74 that Galand teaches the reduction of a call record (as the Examiner did state with respect to the rejections of claims 31, 34, 48, 51, 63, 65, 70-71, 82 and 85; See, Office Action mailed 4/25/03, pg. 7), the Examiner is simply incorrect.

Independent Claim 36

The Applicant respectfully submits that the Examiner's reasoning with respect to independent claim 36 not only blatantly fails to establish a prima facie case of obviousness; but also fails to infer the correct teachings of the Galand reference and attempts to impermissibly fracture the Applicant's claim elements into incomplete concepts so that they can be covered through hindsight.

a. failure to establish a prima facie case of obviousness

It is noteworthy that: 1) independent claim 36 recites subject matter directed to the expansion of the size of a call record (specifically, independent claims 36 recites: "expanding the size of a call record"); and, 2) the Examiner expressly admits that no art has been found that discloses, teaches or suggests the expansion of the size of a call record.

In particular, the Examiner states that "Janning . . . fails to disclose . . . expanding the size of the call record". See, Office Action mailed 4/25/03, pgs. 4-5. Here, the Examiner specifically admits that Janning fails to teach or suggest the expansion of the size of a call record. Moreover, the Examiner states only that Galand teaches "expanding the size of [a] call". See, Examiner's Office Action mailed 4/25/03, pg. 5. Therefore, the Examiner has effectively admitted that no art has been found that is sufficient to cover the expansion of the size of a call **record**; and, likewise, has admitted that a prima facie case of obviousness has not been established.

b. failure to properly infer the teachings of the Galand reference

As discussed at length above regarding independent claims 23, 40, 53, 59, 68 and 74, the Galand reference is devoted to improving the efficiency of calls (not call records). Therefore it is impossible for Galand to teach or suggest “expanding the size of a call record”. If the Examiner meant to state in the Office Action mailed 4/25/03 with respect to independent claims 36 that Galand teaches the expansion of a call record (as the Examiner did state with respect to the rejections of claims 29, 32, 46, 49, 64, 69, 80 and 83; See, Office Action mailed 4/25/03, pg. 6), the Examiner is simply incorrect.

c. impermissible fracturing of the Applicant’s claim elements

If the Examiner meant to state in the Office Action mailed 4/25/03 with respect to independent claim 36 that Galand teaches the expansion of a call record (as the Examiner did state with respect to the rejections of claims 29, 32, 46, 49, 64, 69, 80 and 83; See, Office Action mailed 4/25/03, pg. 6), the Examiner is not only incorrect with respect to the actual teachings of Galand but is also impermissibly fracturing the Applicant’s claim elements into pieces of word phrases in an attempt to cover the Applicant’s claims through hindsight.

Specifically, it appears as though the Examiner has reasoned that Galand teaches “expansion of a call size record” and Janning teaches “in response to a call transitioning from an active phase to a release phase”. See, Office Action mailed 4/25/03, pgs. 4-5. Breaking down the Applicant’s claim elements into specific word phrases amounts to an obvious attempt on the part of the Examiner

to use hindsight. To wit, the Applicant respectfully submits that the prior art is perhaps rich with instances of a call record size being expanded in response to various events other than a call transitioning across active and release phases; and, likewise, the prior art is perhaps rich with other instances of specific acts other than the expansion of a call size record that take place in response to a call transitioning across active and release phases.

However, piecing together various “word phrases” from such references so as to cover the Applicant’s express claim language is an unacceptable strategy for rejection as it clearly invokes the use of hindsight. “[I]t is impermissible to use the claimed invention as an instruction manual or ‘template’ to piece together the teachings of the prior art so that the claimed invention is rendered obvious . . . [o]ne cannot use hindsight reconstruction to pick and choose among isolated disclosures in the prior art to deprecate the claimed invention.” In re Fitch 972 F.2d 1260, 1266 (Fed. Cir. 1992). If PTO examiners were allowed under the law to break apart complete concepts into smaller fragments so as to effectively destroy the underlying novelty of an applicant’s ingenuity, and if, PTO examiners were further allowed to cover these smaller fragments with mere identical or similar word phrases found in the prior art (as the Examiner appears to be attempting with respect to claim 36) no patent application might ever be deemed allowable. Unless the Examiner can find prior art that teaches a call record size expansion in response to (e.g., “triggered by”) a transition from an active phase to a release phase, independent claim 36 is allowable over the prior art and must be allowed to pass to issuance.

As a consequence, the Applicant respectfully submits that each of the independent claims of the present Application are allowable and, therefore, all claims of the present application are in condition for allowance. The Applicant therefore respectfully requests the allowance of all claims.

If there are any additional charges, please charge them to our Deposit Account Number 02-2666. If a telephone conference would facilitate the prosecution of this application, the Examiner is invited to contact Robert B. O'Rourke at (408) 720-8300.

Respectfully submitted,

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